

R E M A R K S

Claims 1-15 and 17-28 are pending in this application. In the final office action mailed December 15, 2004, claims 1-15 and 17-28 were rejected under 35 U.S.C. § 103(a) as being obvious in view of U.S. Patent No. 5,487,012 (Topholm et al.) and U.S. Patent No. 6,595,317 (Widmer et al.). Reconsideration is respectfully requested.

The Invention

A hearing instrument that resides at least partly in the ear canal must be precisely sized to fit properly and avoid creating discomfort for the user. Such an instrument is achieved in part by initially creating a virtual or digital representation of the instrument shell and adjusting the fit of the digital representation of the outer surface of the shell in a digital representation of the ear canal.

Rejection under 35 U.S.C. § 103(a)

The Cited References Fail to Teach All of the Claim Elements

All of the pending claims were rejected under 35 U.S.C. § 103(a) as being obvious in view of Topholm et al. and Widmer et al. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." M.P.E.P. § 2143.03 (8th ed., rev. 2, May 2004), p. 2100-133 [emphasis in original], citing In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Each of the three independent claims contain limitations directed to adjusting the fit of the instrument shell in the ear:

adjusting the fit of the digital representation of the outer surface of the shell in the digital representation of the ear canal [claim 1]

means for adjusting the fit of the digital representation of the outer surface of the shell in the digital representation of the ear canal [claim 17]

adjusting the fit of the digital representation of the outer surface of the shell in a digital representation of the ear canal [claim 28]

As admitted in the office action (page 2), Topholm et al. does not disclose, teach, or suggest "adjusting the fit of the digital representation of the outer surface of the shell...."

The action goes on to state that "[i]t would have been obvious to one skilled in the art at the time the invention was made to provide one or more suitable component[s] and/or structural element[s], such as a surface vent (31) taught by Widmer et al. for the component database (15) for further adjusting the digital representation of the outer surface of the shell in the digital representation of the ear canal...." However, the addition of a surface vent or any other component or structural element to the shell does not adjust the "fit" of the hearing instrument in the ear canal. Thus, Widmer et al. does not cure the deficiency of Topholm et al. Moreover, there is no disclosure, teaching, or suggestion in either reference that would lead one skilled in the art to "adjust[] the fit of the digital representation of the outer surface of the shell in the ear canal" (or the outer ear). Therefore, the combination fails to render the claimed invention obvious as it lacks all of the claimed elements.

The Naked Assertion That it Would Have Been Obvious Is Insufficient

Even assuming that the two references would supply all of the limitations of the claims, the bald assertion that "it would have been obvious" to have made the necessary modifications to Topholm et al. in view of Widmer et al. cannot by itself support a finding of obviousness; some suggestion or motivation is required. In re Lee, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002) (Board's affirmance of PTO's unsupported § 103 rejection reversed). And, "[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references." M.P.E.P. § 2143.01 (8th ed., rev. 2, May 2004), p. 2100-129, citing Al-Site Corporation v. VSI International, Inc., 174 F.3d 1308, 1324, 50 U.S.P.Q.2d 1161, 1171

(Fed. Cir. 1999) (“[s]kill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case...”).

Indeed, on this record, the only motivation for making such a combination and then supplying the missing elements is found in the applicant’s claims and it is improper to use the claims in this fashion. M.P.E.P. § 2143 (8th ed., rev. 2, May 2004), p. 2100-129, (“[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure”); In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999) (“[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.”); In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (“rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’”).

Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01 (8th ed., rev. 2, May 2004), p. 2100-131, citing In re Mills, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990) (“[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification,” citing In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)). Thus, absent the suggestion or some objective reason to utilize the structure of Widmer et al., as well as the missing elements, the

combination is improper and cannot support a finding of obviousness. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). "Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done." Id. at 1302.

It must again be noted that the combination suggested here is ineffective as both of the references fail to teach all of the claimed elements. Additionally, there is no suggestion or teaching in either reference to modify either in such a manner that would result in the claimed invention.

Conclusion

The applicants believe that they have responded to all of the issues raised in the office action and submit that all of the pending claims are allowable. Thus, it is respectfully requested that the examiner pass the application to allowance. The examiner is invited to call the undersigned if there are any questions concerning the application.

Dated: January 5, 2005

Respectfully submitted,



Joel Miller
Reg. No. 29,955
17 Westwood Drive South
West Orange, N.J. 07052
(973) 736-8306

Attorney for Applicant(s)